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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,302	11/09/2001	Charles L. Lindsay	4239011527D3	2757

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EXAMINER

PATEL, AJIT

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/036,302	Applicant(s) LINDSAY ET AL.	
	Examiner AJIT G. PATEL	Art Unit 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-58,61-66,68-75 is/are rejected.
- 7) ☒ Claim(s) 59,60,67 and 76 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claim 56 recites the limitation "the base station" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 71 recites the limitation "the base station" in line 4. There is insufficient antecedent basis for this limitation in the claim.

2. Claim 56 is objected to because of the following informalities: In line 2, "a second base station" should be "the second base station". Appropriate correction is required.

Claim 71 objected to because of the following informalities: In line 2, "a second base station" should be "the second base station". Appropriate correction is required.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 50-58,61-66,68-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,212,173. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims 50,61,68 and 72 is the same as the scope of the

claims 1 and 6. The following is the comparison between the claims in the instant application and the patented claims. The step of transmitting bearer traffic message from a user station to the first base station --- a plurality of time slots is the same as the step of communicating between a mobile station and a first station; receiving bearer traffic messages --- time slots of the TDMA system is the same as communicating between a mobile station and a first base station; transmitting control traffic messages --- a single time frame is the same as exchanging a plurality of control traffic messages --- a single time frame; receiving control traffic messages --- the second base station is the same as handing off communication --- a second base station.

Regarding claims 51, the step of establishing --- the control messages is the same as the step of establishing --- plurality of control traffic messages as recited in claim 2.

Regarding claim 52, the step of receiving a time slot --- the control traffic messages is the same as assigning a time slot --- plurality of control traffic messages as in claim 3.

Regarding claim 53, the step of transmitting bearer traffic messages --- the base station is the same as the step of exchanging bearer traffic messages --- for bearer communication as recited in claim 4.

Regarding claim 54, the step of receiving control traffic messages --- a next slot pointer is the same as the step of transmitting a next slot pointer --- the mobile station as recited in claim 5.

Regarding claim 55, the recitation wherein the next slot pointer points --- to the second base station is the same as next slot pointer --- to the mobile station as recited in claim 5.

Regarding claim 56, the recitation wherein transmitting control traffic messages --- the single time frame is the same as the step of establishing a duplex communication link --- control messages recited in claim 2.

Regarding claim 57, the recitation of wherein transmitting control messages ---from the first base station is the same as the step of communicating between a mobile station and a first base station and also the step of exchanging a plurality of control traffic messages between the mobile station and the second base station recited in claim 1.

Regarding claim 58, it would have been obvious to one skilled in the art discontinuing the transmitting and receiving the bearer traffic messages in order to transmit and receive control messages.

Same rejection is applied to claims 61-66,68-75.

5. Claims 59,60,67,76 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJIT G. PATEL whose telephone number is 571-272-3140. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2664

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AP


Ajit Patel
Primary Examiner